

Appl. No. 09/926,491
Amendment dated: August 7, 2003
Reply to OA of: April 7, 2003

REMARKS

Applicants acknowledge with appreciation the indication of allowable subject matter in connection with this application. Applicants believe that all the claims are patentable as discussed below and have not currently amended the claims to rewrite the allowable subject matter in independent form pending the resolution of the issue on the basis of anticipation of the claimed compounds.

The rejection of claim 21 under 35 U.S.C. 112, first paragraph, has been carefully considered. While Applicants believe that this claim is fully supported by the specification to one of ordinary skill in the art, without undue experimentation, the claim has been canceled from the present application in an effort to expedite the prosecution to an early allowance of all the claims in the application. Applicants retain the right to file a further application claiming this subject matter.

The rejection of claims 1-5, 8-13, 17 and 19 under 35 U.S.C. 102(b) as being anticipated by Dolence et al. has been carefully considered but is most respectfully traversed. In the Official Action, it is urged that Dolence et al. teach the compound 3-methoxy-19-norcholesta-1,3,5(10)-triene-22,25-diol (see Abstract). The compound taught by the reference is said to be encompassed by the instant claims. This rejection has been carefully considered but is most respectfully traversed.

Applicants acknowledge that the Abstract which the Examiner has provided does indeed name the compound 3-methoxy-19-norcholesta-1,3,5(10)-triene-22,25-diol and gives its structural formula (the second formula in the right hand column). However, this compound is not described anywhere in the Dolence article which is purportedly being abstracted. Applicants most respectfully submit that one of ordinary skill in the art will see that the article is exclusively concerned with reactions of 20-hydroxypregnane-22-carboxaldehydes to give products such as 20,22,25-triols, so that in all cases a hydroxyl group is present at the 20-position. Accordingly the actual disclosure of the Dolence article does not place the public in possession of the compound 3-methoxy-19-

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norcholesta-1,3,5(10)-triene-22,25-diol and therefore does not anticipate any claim of the present application, since the present compounds do not have 20-hydroxylation.

Clearly, one of ordinary skill in the art would appreciate the error in the Abstract and therefore the cited compound is not placed in possession of the public by this disclosure and it is not legally sufficient as a reference. See *In re Wilder* 166 USPQ 545. Accordingly, there is no anticipation and it is most respectfully requested that this rejection be withdrawn.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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REF:kdd
A01.wpd

August 7, 2003